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EXAMINER

CHANG, SHIRLEY

ART UNIT PAPER NUMBER

2614

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,014

Applicant(s)

MAMEDA, KENJI

Examiner

Shirley Chang

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) ✓
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 102

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 8, 9, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Portuesi (US 5,987,509).

As to claim 1, the claimed "separation unit separation unit separating video from data included in a broadcast wave" is met by the URL Decode Unit 68 (column 9, lines 38-42) as shown in Figure 5, and the claimed display unit displaying the video and button is met by display window 28 as shown in Figure 4 and the hotspot 40 (claimed button) in Figure 4, wherein said Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 (column 6, lines 34-37) (claimed "display of video associated data corresponding to a button selected by a user").

As to claim 8, the claimed separation and display unit are met as discussed in claim 1. The claimed communication unit is met by system 4 as shown in Figure 4, which includes "user input device 14" (column 4, line 40) (claimed "receiving an externally applied command") and "displays internet/intranet URLs embedded in a movie file" (column 4, lines 29-31) (claimed "transmitting video associated data included in the data... to an external source").

As to claim 9, the claimed still picture production unit is met by display window 28, wherein system 4 transmits the hotspots URL data and still picture (column 4, lines 37-39) (claimed "communication unit transmitting of button data...and the still picture...to an external source). As is well known, a typical broadcast displays 30 frames per second, which equates to displaying 30 "still pictures" per second.

As to claim 17, claimed separation unit and display unit are met as discussed in claim 1. The claimed select unit is inherent in a system that allows hotspot selection (button selection) (column 6, lines 34-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi (US 5,987,509).

As to claim 2, there inherently exists a claimed cursor move unit, since there is a pointer 38 (cursor) as shown in Figure 4. There also inherently exists a claimed button retrieval unit since there is a hotspot 40 (button), also shown in Figure 4; wherein said Display Window 28 unit displays Caption 34 corresponding to selecting hotspot 40 (column 6, lines 34-37) (claimed "displays video associated data corresponding to the button").

Although the Portuesi reference fails to disclose an infrared receive unit, the examiner gives Official Notice that it is notoriously well known in the art to utilize an infrared receiving pointing device such as the TV receiver remote control, which thereby gives existence to an infrared receive unit. Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to use an infrared device, which effectively makes necessary the existence of an infrared receive unit.

3. Claims 3, 4, 10, 11, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi (US 5,987,509) in view of Narayan et al. (US 6,859,937).

As to claim 3, the claimed separation and display unit are met as discussed in claim 1. Portuesi teaches an URL Window 30 as shown in Figure 3 activated upon hotspot selection (column 4, lines 42-45). Although Portuesi does not teach email specifically, Narayan et al. teaches an email 104 function and button as shown in Figure 4. Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to send and receive email in the URL Window 28 after user selects a hotspot (claimed "button data corresponding to button selected by a user to produce email."

As to claim 4, the infrared receive unit, cursor move unit, and button retrieval unit are met as discussed in claim 2. Claimed mail production unit is met by that discussed in claim 4 since the data that is obtained corresponding to the one the user selected will effectively have the same data that the button retrieval unit receives from the button the user selects.

As to claim 10, the claimed separation unit and display unit are met as discussed above for claim 8. Since there is an "user input device...which can comprise a keyboard and a mouse or other pointing device," (column 4, lines 40-43) there exists, effectively, the claimed "first communication unit receiving an externally applied command." Also, since there is an URL Window 30 as shown in Figure 3, email can effectively be accessed and

received from an external source as discussed in claim 3, thereby meeting the claimed “communication unit...receiving electronic mail.” Furthermore, since email can be accessed, there is inherently a communication unit that meets the claimed “second communication unit transmitting email.”

As to claim 11, since there exists still pictures as discussed in claim 8 and Movie File with Embedded URLs 60, there inherently exists a “broadcast receiver comprising a still picture production unit”. The communication unit as explained in claimed 10 inherently transmits the hotspot 40 information (button information) and still picture as previously discussed to the display window 28 (claimed communication unit sending of button data and still picture to external source).

As to claim 12, the claimed communication unit is met as discussed above for claim 8, and the claimed display is met as that discussed in 1 and 8 for displaying the claimed button and the image received by said communication unit, respectively.

As to claim 13, the claimed communication unit is met by that described in claim 12 and claim 10 for “receiving data and an image” and “transmitting electronic mail” respectively. The claimed display unit and select unit are met by that discussed in claim 12, and the claimed mail production unit is met by that discussed in claim 4 since the button data retrieved by the button retrieval unit in claim 4 will have the same effect as the data that is retrieved by the select unit.

4. Claims 5, 6, 7, 14, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portuesi (US 5,987,509) in view of Narayan (US 6,859,937), in further view of Shaw et al. (US 6,516,341).

As to claim 5, the Portuesi reference does not teach a using a template to produce email. However, Shaw et al. discloses clicking on a button, which opens a screen and creates a template for an email message (column 18, lines 1-5) (claimed email using template in button data). Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference use templates to “enable the user to easily compose an email message” (column 6, lines 20-25).

As to claim 6, the Portuesi reference does not teach using a button including a mail address. However, Shaw et al. discloses, “a template for a email message, with the address field completed” after the user “clicks on the reply button 803” (column 18, lines 1-5) (claimed email “produced with mail address included in button data”).

Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference use templates to produce email to “enable the user to easily compose an email message” (column 6, lines 20-25).

As to claim 7, the Portuesi reference does not teach the user information managing unit. However, Shaw et al. discloses that “existing email networks determine at the server side and while the user is online who the user is and that user’s mail server” (column 3, lines 1-3) and a “member profile stored at the server system 104 on the database management system 106 (column 12, lines 57-60) (claimed “mail production unit that produces email based on user information under control of user information managing unit”). Accordingly, it would have been clearly obvious to one of ordinary skill in the art to modify the Portuesi reference to use an information managing unit “to aid in selecting or targeting advertisements and email messages...to desired users” (column 12, lines 52-53).

As to claim 14, claimed mail production unit is met for same reasons as mentioned in claim 5.

As to claim 15, claimed email “produced with mail address included in button data” is met for same reasons as mentioned in claim 6.

As to claim 16, claimed mail production unit is met for same reasons as mentioned in claim 7.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley Chang whose telephone number is (571) 272-8546. The examiner can normally be reached on 8:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2614

SC



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